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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,991	08/31/2000	Donald L. Yates	MTI-31046	4383
31870	7590	10/09/2003	EXAMINER	
WHYTE HIRSCHBOECK DUDEK S.C. 111 E. WISCONSIN AVE. SUITE 2100 MILWAUKEE, WI 53202			TRAN, BINH X	
			ART UNIT	PAPER NUMBER
			1765	

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/652,991

Applicant(s)

YATES, DONALD L.

Examiner

Binh X Tran

Art Unit

1765

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 12, 13, 26, 28, 79, 111-126, 131-133, 146-148, 150-153, 155, 157 and 158.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 08-29-2003
10. ☐ Other: _____

NADINE G. NORTON
PRIMARY EXAMINER



Continuation of 5. does NOT place the application in condition for allowance because:

The applicants argue that the amendment after final filed on 7-17-2003 intended to correct the typographical error in claim 79 from "inorganic" to "organic" and should not raise any new issue. The examiner disagrees with applicants' argument. The examiner never treats the term "inorganic" as a typographical error. The examiner understands the applicant's situation. However in the final rejection mailed on 5-29-2003, the examiner cannot assume the term "inorganic" is a typo error for another term because the term "inorganic" exists in English dictionary. In the final rejection, the examiner treat claim 79, which has the term "inorganic", differently from all other claims. The applicants also argue that the new limitation in claim 79 should not raise new issue because the new limitation were considered by the examiner in other pending claims such as 12, 146 and 152. The examiner disagrees with the argument. The examiner considers the scope of each claim base on the combination of ALL limitations in the claim (not base on individual limitation). Since the applicants never disclose the new limitation "organic" in claim 79 before the final rejection, it certainly raises new issues and would require further consideration in the amendment after final for this claim.

The applicants further argue that "the examiner, in essence, contends that Bartlett, explicitly or inherently, discloses an aqueous etch solution at is 2:1 (v/v) solution of HF: organic acid(s)". The examiner strongly disagrees with this statement. The examiner only contends that Bartlett discloses the etch solution having HF component and organic acid component. The examiner never contends that Bartlett teaches a 2:1 solution of HF: organic acids as stated by applicants. In the final rejection, the examiner acknowledges that the cited prior arts fail to disclose the specific ratio of HF: organic acid. However, the examiner interprets that Bartlett teaches that the concentration of each component is a result effective variable. As discussed in earlier rejection, the result effective variable is commonly determined by routine experiment. The process of conducting routine experiments so as to produce an expected result is obvious to one of ordinary skill in the art. The examiner still maintains that it would be obvious to perform routine experiment to obtain optimal concentration ratio as an expected result.

The applicants further argue that Bartlett teaches away from the present invention by using NH_4F . The examiner disagrees. Teaching a way is not teaching away. Teaching another way refers to the fact that a reference teaches a preferred, or an alternative way to claimed way of accomplishing something.

Binh X. Tran